

Remarks

Introduction

Claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40, and 42-45 were pending. By way of this response, claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40, and 42-45 have been cancelled without prejudice; and claims 48-113 have been added. Support for the new claims can be found in the application as originally filed, and care has been taken to avoid introducing new matter. In addition, the new claims presented herein are within the scope of the original claims and do not introduce new issues.

In view of the above, claims 48-113 are currently pending.

Applicant respectfully requests entry of this Amendment and reconsideration of the rejections.

Rejection Under 35 U.S.C. § 112, first paragraph

Claims 4, 7, 10, 19, 22, 24, and 27 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly not complying with the enablement requirement.

Applicant does not concede to the correctness of the rejection. However, to advance the prosecution of the present application, claims 4, 7, 10, 19, 22, 24, and 27 have been cancelled without prejudice.

Applicant submits that the newly added claims submitted herewith do not recite the language identified in the Office Action, and that the newly added claims are enabled by the specification of the present application.

In view of the above, applicant submits that the rejection under 35 U.S.C. § 112, first paragraph cannot be properly maintained and requests that the rejection be withdrawn.

Rejection Under 35 U.S.C. § 112, second paragraph

Claims 4, 7, 10, 16, 19, 22, 24, 27, 32, 34-36, 38, 40, and 42-45 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

Applicant does not concede to the correctness of the rejection. However, to advance the prosecution of the present application, claims 4, 7, 10, 16, 19, 22, 24, 27, 32, 34-36, 38, 40, and 42-45 have been cancelled without prejudice.

Applicant submits that the newly added claims submitted herewith do not recite the language identified in the Office Action, and that the newly added claims are definite.

In view of the above, applicant submits that the rejection under 35 U.S.C. § 112, second paragraph cannot be properly maintained and requests that the rejection be withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40, and 42-45 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Hu (US 20010044482), by Gordon (US 4,123,408), or by Shah (US 4,462,665). Claims 1-3, 10, 16-19, and 27 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Tanaka (US 6,008,170), or Salpekar (US 6,440,366).

Applicant does not concede to the correctness of the rejections. However, to advance the prosecution of the present application, the previously pending claims have been cancelled without prejudice, and new claims 48-113 have been added. Applicant traverses each the rejections as each relates to the present claims, and submits that the rejections cannot be properly maintained.

MPEP § 2131 provides that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

None of the references, Hu, Gordon, Shaw, or Tanaka, specifically describe a sealed contact lens package, let alone a sealed contact lens package that comprises a cavity, a contact lens in the cavity, a liquid in the cavity and in contact with the contact lens, and a seal surrounding the cavity. Therefore, a rejection of claims 48-100 over Hu, Gordon, Shaw, or Tanaka cannot be properly maintained and should be withdrawn. Since Hu, Gordon, Shaw, or Tanaka do not describe a contact lens in a sealed package, the rejection of claims 101-113 over Hu, Gordon, Shaw, or Tanaka cannot be properly maintained and should be withdrawn.

Salpekar does not describe a contact lens comprising the reaction product of a polymerizable composition comprising an amount of a water soluble polymer and at least one monomer, and a liquid in a contact lens package cavity and in contact with the contact lens, and that includes an additional amount of the water soluble polymer. Therefore, a rejection of claims 48-62 over Salpekar cannot be properly maintained and should be withdrawn. Salpekar does not describe a liquid in the cavity of a contact lens package and in contact with a contact lens, which includes polyvinyl pyrrolidone. Therefore, a rejection of claims 63-83 over Salpekar cannot be properly maintained and should be withdrawn. Salpekar does not describe a contact lens that comprises the reaction product of a polymerizable composition comprising an amount of a comfort agent and at least one monomer, and a liquid in a contact lens package cavity and in contact with the contact lens, and includes an additional amount of the comfort agent. Therefore, a rejection of claims 84-100 over Salpekar cannot be properly maintained and should be withdrawn. Since Salpekar does not describe a contact lens that comprises the reaction product of a polymerizable composition comprising a comfort agent, the rejection of claims 101-113 over Salpekar cannot be properly maintained and should be withdrawn.

In view of the above, applicant submits that the rejections, as applied to the newly added claims, are unsupported by the cited references and should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, applicant submits that the present claims, that is claims 48-113 are in condition for allowance. Notice of which is respectfully requested. If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned representative invites the Examiner to telephone him at the number provided below.

Respectfully submitted,

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